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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,156	12/05/2001	Hiroshi Tomaru	Q67419	2261

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EXAMINER
MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
3713	4

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary	Application No.	Applicant(s)	
	10/002,156	TOMARU ET AL.	
	Examiner	Art Unit	
	C. Marks	3713	

-- The MAILING DATE of this communication appears on the c ver sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *05 December 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. A number of proper punctuation that would make the claims definite and less narrative are missing and are required in order to make the claims more readable and definite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagao et al. (US Patent No. 6,394,898) in view of NHL Faceoff (Sony Computer Entertainment) further in view of Dickinson et al. (US Patent No. 6,224,485).

Nagao et al. disclose a gaming machine (FIG 1, reference 10) that wherein a plurality of racing members in the form of miniature horses (FIG 1, reference 14) that each have a member name (Column 13, lines 6-9) and participate in a plurality of races (Column 1, lines 30-34). Nagao et al. disclose a name associated with every race (FIG 12, SEGA CUP) and with each horse (FIG 12).

The gaming machine of Nagao et al. also discloses a race record evaluator that evaluates race records for each racing member in accordance with race results for a set number of races (FIG 12, Column 11, lines 57-67; Column 12, lines 1-8). The evaluator displays a ranking table wherein the racing members are ranked in accordance with the race results (FIG 12, condition rating). Though the table does not explicitly disclose the display of the number of prizes acquired by each horse, the table is used to aid the user in determining handicapping factors related to each horse in order to assist the user in placing bets regarding the performance of the horses (Column 11, lines 57-67). The table discloses race information; including place finishes for the past four races the horse participated in (FIG 12). One of ordinary skill in the art could thus determine from this information the prizes associated with each place finish and henceforth the inclusion of such information in the table would have been obvious to one of ordinary skill in

the art who would be motivated to make such an inclusion in order to further aid the user in determining horse performance in relation to betting.

Nagao et al. do not disclose that parts of the names assigned to the horses are based upon the registration name of a game player. Further, Nagao et al. do not disclose a special type of race wherein the race name includes part of the player name, based upon the first-place ranking of the associated horse member.

It is notoriously well known in the art that players who create characters are given the power to name the characters based upon any names they desire, including part of the player's own name. This fact is employed in video games, online role-playing games, fantasy sports management games, as well as online communication games. NHL Faceoff provides an example of this fact by disclosing the ability of a player to register his or her name in a registration screen (Create a Player, page 7). The player can name the player as they wish and in the example disclosed, the name of an actual user is used. From this registration information provided by the player, the name of the user is assigned to the character as the character's name for use in the game.

Dickinson et al. disclose a gaming machine wherein a plurality of games can be played and upon the player achieving a score better than any of the previous games, the machine will designate the game as special in the manner that the machine will assign the player name to the game as part of the game's name thereof (FIG 4, references 80 and 82). This will occur when the player to which the name is assigned has a score or record better than any other of the previous or current users (Abstract) thus ranking the player in first place among all the other players (Column 1, lines 58-61). Dickinson et al. further teaches that players enjoy games with

such high scorer displays because for those who have achieved a high score, the display provides a record of the player's accomplishments and gives them bragging rights in the particular game until unseated (Column 1, lines 17-22). Dickinson et al. also discloses it has been found that player competition engendered by high-scorer displays can attract more frequent play of the underlying games and accordingly where such displays are incorporated in coin-operated video games, greater revenues can accrue to the owner (Column 1, lines 26-31). Further, Dickinson et al. also teach that by displaying the high-scoring players during active play, greater recognition is given to the player (Column 1, lines 47-51).

It would have been obvious to one of ordinary skill in the art to allow the characters in the Nagao et al. to be named based upon a name registered by the player. One of ordinary skill in the art would be motivated to make this incorporation as by allowing the default names in Nagao et al. to be changed by the player, as disclosed by NHL Faceoff, the player would feel as though the character is truly personalized and thus the player would have a greater connection to the character as the player would feel the character is a true representation of the player, not just a default value. It is well known in the art that by allowing the player to personalize the character, the appeal of a game that involves personalization would be a greater sense of affinity to the game by the player and a higher level of immersion of the users into the game due to the personalization. Therefore, the player would be more likely to play and continue playing the game thus creating greater revenue for the game owner.

Further, it would have been obvious to one of ordinary skill in that upon allowing the player to designate their name to be used as the name for the character, to further display their name as part of the name for the next segment of the game in recognition of achieving a first

place in the rankings as disclosed by Dickinson et al. One of ordinary skill in the art would be motivated to incorporate this feature of Dickinson et al. into the game in order to provide recognition to the player who has achieved top status. As disclosed by Dickinson et al., players enjoy games with such high scorer displays that name the game segment after them because for those who have achieved a high score, the display provides a record of the player's accomplishments and gives them bragging rights in the particular game until unseated (Column 1, lines 17-22). Dickinson et al. also discloses it has been found that player competition engendered by high-scorer displays can attract more frequent play of the underlying games and accordingly where such displays are incorporated in coin-operated video games, greater revenues can accrue to the owner (Column 1, lines 26-31).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,019,369: Horse racing game where a plurality of racing members compete in a number of races to determine a winner.

US Patent No. 5,595,389: Teaches of personalization in a video game in accordance with player identity and personal information in order to create a video game in which the player can better relate and feel more like it is their own.

US Patent No. 5,411,258: Interactive video horse racing game that allows player to bet on performance of horses and to change the parameters associated with naming in the game.

Tiger Woods PGA Tour 2001: Player has the ability to register his or her name and then the name is assigned to an associated character wherein the name of the character is used in competition and can be displayed on a leaderboard.

Paintball – NET: Teaches of a process at sign in that requires the player to register a name to be assigned to a character and teaches that preferably the player will use part of their real name.

US Patent No. 6,287,201: Arcade game wherein the player can enter their name and the name is associated with a character for use in the game.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Martin-Wallace can be reached on (703)-308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

cmm
cmm
May 12, 2003

VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER
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